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12/23/96

081 786
S.N. 392,934 File No. PD3033 Date Mailed 10/23/96 By: WY/mah
Title: Immune reactive peptides from EB virus
(Client Name) g & j

The Following, due 10/23/96 in the U.S. Patent & Trademark Office was received in the Patent & Trademark Office on the date stamped hereon:

☐ Amendment
☐ TM Appln., Including Specimens
☐ PCT Application Including
 Spec. Request
☐ Application for Patent Including
 Pages Spec.: No. of Claims
☒ Declaration, Affidavit or Oath Signed
☐ Assign: Ck. No. _____ for \$ _____
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Priority: ☒ Parent of America to Adden to
Orig. named Inventors.

☐ Drawings: # of Sheets _____
 Formal Informal
☐ Issue Fee Transmittal
☐ Letter Re _____
☐ Notice of Appeal
☐ Petition for Ext of term
☒ Advance soft copy order:
 Ck. No. 1144 for \$ 930
☐ Certified Copy: # _____ of Docs.
☒ Power of Attorney 37CFR.1.48
☒ Renewal Petition (3)
☒ Verified Stmt of Facts
☒ Dec of John Wethelall
☒ Copy of Ex ctd Assmt

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PATENT
7586D3033

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:)
)
SMITH, et al)
)
Serial No: 08/392,934)
)
Filed: September 15, 1993)
)
For: IMMUNOREACTIVE PEPTIDES FROM)
EPSTEIN-BARR VIRUS)
_____)

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as first class mail in an envelope addressed to: Assistant Commissioner of Patents, Washington D.C. 20231, on

10/23/96
Date of Deposit

Wei-ning Yang
Name

[Signature] 10/23/96
Signature Date

VERIFIED STATEMENT OF FACTS

Assistant Commissioner of Patents
Washington, D.C. 20231

Dear Sir:

In response to the Decision on Petition dated May 23, 1996, we have further investigated when the error of omitting inventor Dr. Susan Pothen Varghese without deceptive intent was discovered and how it occurred. Such investigation has revealed further details about when and how the error of omitting inventor Dr. Varghese occurred. Nevertheless, as shall be shown below, the omission of Dr. Varghese as a named co-inventor in the originally filed application was inadvertent and without deceptive intent; and due diligence has been made to correct the inventorship.

The omission was an error without deceptive intent. We understand that the parent application to the present application was filed under the Patent Cooperation Treaty (PCT) on September 15, 1993. We further understand that the present

application is a Continuation-in-Part (CIP) application of a grandparent application filed on September 15, 1992, and abandoned on January 31, 1994. The grandparent application named only us, Richard S. Smith, Gary R. Pearson, and D. Elliot Parks as inventors. The grandparent application was filed without Oath and Declaration by the named inventors.

According to Dr. Parks, he reviewed the application before it was filed. Dr. Smith and Dr. Pearson have no recollection of reviewing the application before it was filed. Dr. Parks was not then aware of Dr. Varghese's involvement in the work as he worked on opposite coasts of the United States at that time. Thus, Dr. Parks was unaware, and believes he did not inform counsel, that Dr. Varghese should be named as inventor.

The oath and Declaration were executed by the named inventors on or about November 3, 1992. Shortly after the execution of the Oath and Declaration, according to Dr. Gary R. Pearson, Dr. Pearson recognized that his Ph.D. student, Dr. Varghese, had had substantial involvement in the subject matter of this application. Therefore, according to Dr. Pearson, he believed that in his understanding of the term of inventor, that it might be appropriate to include Dr. Varghese as an inventor.

According to both Drs. Pearson and Parks, Dr. Pearson then contacted Dr. Parks and informed him of his concern about the inventorship. In turn, according to Dr. Parks, Dr. Parks then contacted the attorney of record at the time, Dr. John Wetherell, about the inventorship. We are informed that Dr. John Wetherell contacted the Office of Technology Transfer Department at Georgetown University in about May, 1993, and obtained a copy of the patent memorandum form submitted to Georgetown University for the present application. We are informed that, according to Dr. John Wetherell, the

patent memorandum did not name Dr. Susan Pothen Varghese as an inventor.

Therefore, based on his review of the patent memorandum, we understand that Dr.

John Wetherell concluded that Dr. Varghese should not be named as a co-inventor.

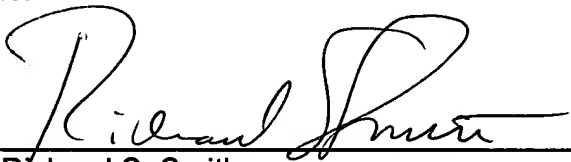
We also understand that on September 15, 1993, the parent application was filed as a CIP application under the PCT naming still only us, Richard S. Smith, Gary R. Pearson, and D. Elliot Parks, as inventors. According to Dr. Pearson, around August 1994, Dr. Pearson again became aware of that Dr. Varghese still had not been included as a co-inventor. To further ascertain Dr. Varghese's role, at the end of August, 1994, Dr. Pearson sent a copy of Dr. Varghese's Ph.D. dissertation to Dr. Wetherell for determining the inventorship. We understand that upon the inspection of the dissertation by Dr. Wetherall, or one of his associates, in about September, 1994, it was concluded that Dr. Varghese was a co-inventor of the above identified invention.

Since recognizing that Dr. Varghese should be named as a co-inventor, we have tried diligently to correct the inventorship. In November, 1994, our attorneys promptly and diligently filed a Request for Addition of Inventor with the International Bureau of the World Intellectual Property Organization. However, the request was rejected on December 2, 1994 for the reason that the time limit for making such a change was expired. Because of this rejection, the application still only named Richard S. Smith, Gary R. Pearson, and D. Elliot Parks as inventors when it entered the national stage in the United States on March 2, 1995. A notice of missing parts was mailed on August 29, 1995 and a petition to correct inventorship was diligently filed in response to the notice of missing parts on December 20, 1995.

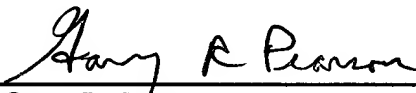
It is, therefore, respectfully submitted that the omission of Dr. Varghese as a named inventor in the originally filed application was inadvertent and without deceptive intent. The PCT file record shows that we diligently tried to correct the inventorship, once the error was found. In light of these facts, we request that the name of Susan Pothan Varghese be added to the present application as a co-inventor, based on the facts set forth above.

We declare that all statements made herein of our own knowledge are true and that all statements made on information and belief are believed by us to be true; and further that the statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment or both, under Section 1001 of title 18 of the United States Code.

Dated: 09/22, 1996


Richard S. Smith

Dated: 10/8/, 1996


Gary R. Pearson

Dated: 9-27, 1996


D. Elliot Parks



PATENT
7586D3033

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:)
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SMITH, et al)
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Serial No: 08/392,934)
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I hereby certify that this correspondence is being deposited with the U.S. Postal Service as first class mail in an envelope addressed to: Assistant Commissioner of Patents, Washington D.C. 20231, on
10/23
September, 1996
Date of Deposit
Wei-ning Yang
Name
[Signature] 10/23/96
Signature Date

ASSENT OF ASSIGNEE TO ADDITION TO
ORIGINALLY NAMED INVENTORS

Assistant Commissioner of Patents
Washington, D.C. 20231

Dear Sir:

ORTHO DIAGNOSTIC SYSTEMS, INC., of 1001 U.S. Route 202, Raritan, New Jersey 08869 and GEORGETOWN UNIVERSITY, of 37th and O Streets, NW, Washington, D.C., 20057, each having an undivided one-half interest in the above identified application, an assignment being concurrently submitted for recordation under separate cover sheet (a copy of that assignment is attached herewith), hereby assents to the correction of inventorship filed herewith.


ORTHO DIAGNOSTIC SYSTEMS, INC., and GEORGETOWN UNIVERSITY state that they have reviewed the executed assignment submitted concurrently herewith for recordation and to the best of their knowledge and belief, title to the above identified

invention and application resides in the herein named assignees, and that the evidentiary document supporting this knowledge and belief, as required by 37 CFR 3.73(b), is the executed Assignment document, said document being filed for recordation concurrently herewith.

The undersigned declare that the undersigned are empowered to sign on behalf of the respective assignee.

ORTHO DIAGNOSTIC SYSTEMS, INC.

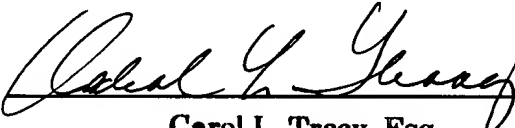
Dated: 9/3, 1996



Michael Stark
Assistant Secretary

GEORGETOWN UNIVERSITY

Dated: 10/9, 1996



Name Carol L. Tracy, Esq.
Director
Title Office of Technology Transfer
Georgetown University